

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 34, 37, 40, and 47-49 are pending in this case. Claims 30-33, 35, 36, 38, 39, and 41-45 are canceled without prejudice or disclaimer, Claims 34, 37, 40 are amended, and new Claims 47-49 are added by the present amendment. As amended Claims 34, 37, 40 and new Claims 47-49 are supported by the original specification,¹ no new matter is added.

In the outstanding Official Action, Claims 30-32, 45, and 46 were rejected under 35 U.S.C. §101; Claims 30-46 were rejected under 35 U.S.C. §102(e) as anticipated by Kim (U.S. Patent No. 6,766,103); Claims 30, 33, 36, 39, and 42 were rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over Claim 1 of U.S. Patent No. 6,658,200; and Claims 31, 32, 34, 35, 37, 38, 40, 41, and 44-46 were rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over Claims 1-5 of U.S. Patent No. 6,658,200 in view of Kim.

It is respectfully noted that the references listed in the Information Disclosure Statement (IDS) filed April 23, 2004 were not indicated as having been considered in the outstanding Office Action. The outstanding Office Action noted that some of the cited references were not translated, and asserted that a statement under 37 C.F.R. §1.97(e) was not included.

Regarding the statement under 37 C.F.R. §1.97(e), such a statement is not necessary because the IDS was filed before the first Office Action. See 37 C.F.R. §1.97(b)(3).

Regarding the request for a translation, a translation of the Office Action from the Japanese Patent Office citing the references submitted on April 23, 2004 or English

¹See, e.g., the specification at page 13, lines 5-26 and Figure 1.

language abstracts of the references were included, and this translation serves as a statement of relevancy under 37 C.F.R. §1.98(3)(i). Accordingly, it is respectfully submitted that the IDS filed April 23, 2004 is in compliance with 37 C.F.R. §§1.97-1.98. Thus, copies of the PTO-1449 form, the translation of the Japanese Office Action, and date stamped filing receipt from this IDS is enclosed. It is respectfully requested that these references be considered.

With regard to the rejection of Claims 30-32, 45, and 46 under 35 U.S.C. §101, Claims 30-32, 45, and 46 are canceled, making this rejection moot. It is respectfully submitted that new Claims 47-49 are in compliance with all requirements under 35 U.S.C. §101.

With regard to the rejection of Claims 30-46 under 35 U.S.C. §102(e) as anticipated by Kim, Claims 30-33, 35, 36, 38, 39, and 41-45 are canceled, making the rejection moot with respect to these claims. To the extent that Kim is relevant to new Claims 47-49, the following comments are presented for the Examiner's consideration.

New Claim 47 recites in part, "said user-defined program chain information including still picture designation information."

Kim describes a rewritable recording medium including user-defined program chain information UD_PCG.² Kim describes that the UD_PCG can include a cell (Cell 4) and a user defined track (UD_TRK). However, it is respectfully submitted that Kim does not describe that the user define program chain information includes still picture designation information. Accordingly, as Kim does not teach "said user-defined program chain information including still picture designation information" as recited in Claim 47, Claim 47 (and Claims 34, 37, and 40 dependent therefrom) is not anticipated by Kim and is patentable thereover.

²See Kim, column 4, lines 18-33 and Figure 5.

As new Claims 48 and 49 recite similar elements to Claim 47, Claims 48 and 49 are believed to be patentable over Kim for at least the reasons described above with respect to Claim 47.

With regard to the non-statutory double patenting rejections of Claims 30, 33, 36, 39, and 42 over Claim 1 of U.S. Patent No. 6,658,200 and Claims 31, 32, 34, 35, 37, 38, 40, 41, and 44-46 over Claims 1-5 of U.S. Patent No. 6,658,200 in view of Kim, these rejections are respectfully traversed in light of the terminal disclaimer submitted herewith.

The filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. The "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Accordingly, Applicants filing of the attached disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission as to the merits of the obviated rejection.

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Accordingly, the outstanding double patenting rejection is traversed and the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Edward Tracy
Registration No. 47,998

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

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